

## SECTION 102 OBJECTIONS

The examiner has rejected claims 1 - 3 AND 7-9 under 35 USC §102(B) per Gregg (2,800,050).

As the court said in Richardson v. Suzuki Motor Co., 9 USPQ2d 1913 at 1920 (Fed. Cir. 1989):

"Rejection for anticipation or lack of novelty requires as the first step in the inquiry, that *all* the elements of the claimed invention be described in a single reference."

In claim 1, applicant claims a remote control *unit*, the remote control *unit* being approximately the size and form factor of a laptop computer and with that *unit* comprising:

- a) a remote graphics display panel for presenting multimedia, video, and data; and
- b) a keyboard having at least 26 keys,
- c) a size and form factor of a laptop computer.

A "unit" is defined as a *single thing or person* according to numerous sources including:

American Psychological Association (APA): unit. (n.d.).

Dictionary.com Unabridged (v 1.1). Retrieved July 03, 2008, from Dictionary.com website:  
<http://dictionary.reference.com/browse/unit>

Chicago Manual Style (CMS): unit. Dictionary.com. Dictionary.com Unabridged (v 1.1).  
Random House, Inc. <http://dictionary.reference.com/browse/unit> (accessed: July 03, 2008).

Modern Language Association (MLA): "unit." Dictionary.com Unabridged (v 1.1). Random House, Inc. 03 Jul. 2008. <Dictionary.com <http://dictionary.reference.com/browse/unit>>

Consequently, in claiming a remote control *unit*, and as described in the text of the specification, and disclosed in the drawings, applicant claims, in a single thing or component having a size and form factor of a laptop computer, all of a graphics display panel and keyboard. Applicant submits that such a form factor as a laptop computer is well known and that the use of clear language indicating the control being a unit, and the subcomponents of the laptop form factor, a keyboard, and a display, in that single unit or thing, is quite different from the cited art of the Examiner of Schindler, which in fact lacks elements of applicants control *unit*.

Schindler, does not have, anywhere in the specification or drawings, a teaching or suggestion of a control unit, which in a "single thing" has onboard, all of the component elements of a laptop form factor, a display, and a keyboard with at least 26 keys in a "single thing" or unit as claimed, described, and shown in the drawings by applicant.

The Examiner suggests that taking a random separate monitor from the large room mounted monitors of Schindler, yields the same thing as Applicant's unit or single item component noted above as having a laptop configuration, a display and a keyboard in a unit (single thing). Not only does Schindler fail to teach or suggest a single *unit* having the keyboard, laptop configuration, and display, the monitors described in Schindler are part of the problem Applicant is solving since they are room-sized displays which are permanently located rather than portable such as in one of the Examiner's cited portion of the specification as a "monitor in the den" (column 6, line 9) vs. the other monitor described as a large monitor in another room suitable for home entertainment (column 5, line 19).

The cited reference of Schindler is an assembly by the Examiner of the individual features of Applicants' invention rather than the invention as a whole and as claimed in a single unit. The Examiner may in misinterpreting the word unit, have strayed into a hindsight selection of individual features. As the Court of Appeals for the Federal Circuit said in Connell et al. v. Sears, Roebuck & Co. (CA FC, 1983), 20 USPQ 193 at 199:

"That features, even distinguishing features, are 'disclosed in the prior art' is alone insufficient. As above indicated, it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made."

As such, the cited reference lacks all of the elements of applicant's claimed device, in a single reference, and the objection based on section 102 is respectfully traversed.

### SECTION 103

The Examiner has objected to claims 7 and 12, pursuant to Section 103, based upon the combination of Schindler and Miller.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**1. The combination cited by the Examiner, does not teach or suggest all of the claimed limitations of applicant's claimed device.**

As noted, in claim 1, applicant claims a remote control unit, the remote control unit being approximately the size and form factor of a laptop computer and with that unit or single thing as defined earlier, comprising:

- a) a remote graphics display panel for presenting multimedia, video, and data; and
- b) a keyboard having at least 26 keys,
- c) a size and form factor of a laptop computer.

As noted, Schindler does not teach or suggest a single unit with all of the elements claimed by applicant in a single unit or control. In fact, Schindler teaches against such a proposition by describing the video displays as located permanently in a room or being large enough for a home entertainment center.

As noted, the Examiner's combination of

Lacking the claimed the single unit with the onboard components of Applicant, any combination with Schindler is also lacking and the combination suggested by the Examiner yielding the objection under section 103 with Schindler is respectfully traversed.

**2. Even if there were not lacking elements in Schindler, there is no suggestion or motivation to modify the reference or to combine reference teachings.**

Schindler as noted, lacks the unit or unitary structure of Applicant of the remote control in a laptop format. Schindler in all cases locates room-sized or desk type video displays and teaches the use of one or more controls to control each display.

There is no teaching or motivation to take one of the multiple room sized or desk-mounted or room-positioned monitors of Schindler, out of its intended room position and making it part of a single unit portable control in the form of a laptop. Schindler is strictly concerned with being able to control multiple room type displays in different permanent positions with a displayless, remote control.

Regarding the combination of Schindler with Allport, the combination as noted lacks elements of applicant's device since Schindler does. Further the suggested combination would require altering the teachings of Schindler of room type displays in permanent positions being controlled by a monitor without a display.

As such, the objections advanced by the Examiner pursuant to section 103 are respectfully traversed.

### Final Remarks

Finally, Applicant's device claims elements providing function, which are neither taught nor suggested in the cited prior art. Applicant as noted in the specification considers the improvement to be substantial and provide great benefits to users who may control video and computers at the same time and even swap the computer functions and display to the on-board display of the control unit.

The art is crowded, and even if the Examiner does not consider Applicant's claimed device a great advance, in the art of remote control devices, it has been established that one should not be deprived of patent protection where it can be shown that *any genuine improvement* has been made, on comparison with other inventions in the art - even if the improvement lacks the appearance of a great advance in the art.

In re Lange, 128 USPQ 365, the CCPA on page 367 states that:  
"We think that the present application is a distinct improvement of Jezalik and represents an advance in the art not obvious, having patentable novelty. The art is a crowded and comparatively simple one and in such an art, great advances are not to be expected. *However patentability will not be denied to an invention which accomplishes a small, but nevertheless genuine improvement not thought of by others..*"

Further, the CCPA in the recent case of re Meng and Driessen, 181 USPQ 94, on page 97, reiterated the principal that even though the invention seems a simple advance over prior art, *after the fact*, simplicity, argues *for*, rather than against patentability.

Considering that Applicant's device has combined elements not taught or suggested in the prior art, and that the single control unit device of applicant provides an improvement thereto, and considering that even minor improvements in the art argue for patentability, all of the claims of the Applicant should now be allowable.

Should the Examiner have any further questions or concerns the Examiner wishes to address, or should the Examiner have suggestions as to language that might more clearly define the invention, the Applicant's attorney would be most receptive to such by telephone.

Respectfully submitted,



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